

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	§	Group Art Unit: 1796
NGUYEN <i>ET AL.</i>	§	
Serial No.: 10/777,412	§	Confirmation No.: 4317
Filed: FEBRUARY 12, 2004	§	Examiner: METZMAIER, DANIEL S.
Title: "METHODS OF TRACKING FLUIDS PRODUCED FROM VARIOUS ZONES IN A SUBTERRANEAN WELL"	§	Atty. Docket No: 2002-IP-006415U1P1D1

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal and the applicable fee. Applicants respectfully request reconsideration of the application in light of the remarks set forth below.

REMARKS

In the Final Office Action dated December 24, 2008 (“Final Office Action”), the Examiner improperly maintained the following rejections:

- Rejection of claims 21, 29, 31 and 44-53 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,582,250 issued to Constien *et al.* (hereinafter “Constien”).
- Rejection of claims 21, 29, 31 and 44-53 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,582,250 issued to Constien *et al.* (hereinafter “Constien”).

In order to form a basis for a rejection under 35 U.S.C. § 102(b), a prior art reference must disclose each and every element as set forth in the claim. MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) § 2131 (2008). “The identical invention must be shown in as complete detail [in the prior art reference] as is contained in the claim.” *Id.* Moreover, in order for a reference or combination of references to form the basis for a rejection under § 103(a), the reference or combination of references must teach or suggest all of the elements of the claim. MPEP § 2142(II). Each of the above-referenced rejections fails to meet one or more of these requirements.

1. Claims 21, 29, 31, 44-53 are not anticipated by Constien

Constien fails to disclose at least two elements of independent claims 21, 44, and 49 -- “a proppant composition comprising a particulate material that has been coated with a coating composition comprising a tracking composition and a resin composition” and “a coating composition comprising a tracking agent.” Therefore, *Constien* cannot anticipate independent claims 21, 44, and 49 or the claims that depend from them.

First, with respect to independent claims 21 and 44, *Constien* fails to disclose a “proppant composition comprising a particulate material that has been coated with a coating composition comprising a tracking composition and a resin composition.” Rather than disclosing a particulate material coated with a coating composition comprising a resin composition as defined by Applicants, *Constien* discloses particulates placed in a fluid comprising viscosifying agents. *Constien*, col. 4, lines 41-45. The Examiner argues that the viscosifying agents disclosed in *Constien* satisfy the “resin composition” requirement in claims 21 and 44, simply because the viscosifying agents are polymeric materials. Applicants respectfully disagree. There is no disclosure in *Constien* that the viscosifying agents disclosed

therein are resins. Similarly, Applicants' specification defines "a resin" as those resin materials which are curable. Specification at ¶¶ [0013] and [0015]. *Constien* does not disclose curable resin compositions. Nor has the Examiner provided any motivation to modify *Constien* to teach this limitation. Therefore, Applicants respectfully submit that *Constien* fails to teach, suggest, or disclose all of the elements of independent claims 21 and 44 as required to anticipate these claims.

Moreover, with respect to independent claims 21, 44, and 49, *Constien* fails to disclose a proppant composition comprising a particulate material that has been coated with "a coating composition comprising a tracking composition." Rather than disclosing a particulate material coated with a coating composition comprising a tracking composition, *Constien* discloses that particulates may be placed in a ZnBr_2 brine. *Constien*, col. 5, lines 60-65. The Examiner argues that when the particulates are placed in this brine, the particulates will be coated with "a coating composition comprising a tracking composition." Applicants respectfully disagree. It is clear from Applicants specification and claims that the "coating composition comprising a tracking composition" recited in claims 21, 44 and 49 forms an actual coating, *i.e.*, an outer layer, on the external face of a particulate such that the coating composition is adhered to the surface of the particulate. The coating composition is adhered to the surface of the particulate so that when the particulate is later produced from the formation to the surface, the zone from which the proppant emanated may be identified. Specification at ¶¶ [0010], [0013] and [0015]. *Constien* discloses no such proppant composition, but rather discloses that a particulate material is simply placed in a brine carrier fluid. As such, *Constien* fails to teach, suggest, or disclose all of the elements of independent claims 21, 44 and 49 as required to anticipate or obviate these claims.

The Examiner failed to address any of these deficiencies of *Constien* in the Advisory Action mailed September 16, 2009 ("Advisory Action"). Furthermore, the Examiner argues that the claims are drafted in a product-by-process format. Applicants note that a product-by-process claim is a product claim that defines the claimed product in terms of *a process*. See MPEP § 2173.05(p). Moreover, product-by-process claims define the invention solely or primarily in terms of process. See, e.g., *In re Hughes*, 496 F.2d 1216, 182 USPQ 106 (CCPA 1974). Applicants do not define their composition in terms of a process. Therefore, Applicants respectfully submit that independent claims 21, 44, and 49 are not product-by-process claims but

instead are composition claims directed to a proppant composition and a coating composition. Therefore, Applicants maintain that the rejections of independent claims 21, 44, and 49 and dependent claims 29, 31, 45-48, and 50-53 over *Constien* are not proper, and respectfully request withdrawal of these rejections.

2. Claims 21, 29, 31, 44-53 are not obviated by *Constien*

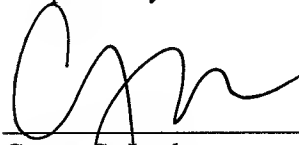
Claims 10-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Constien*. As discussed above in Section 1, *Constien* fails to teach each and every limitation of independent claims 21, 44, and 49. Nor does the Examiner provide any rationale to establish that *Constien* teaches the missing elements of claims 21, 44, and 49. Claims 29, 31, 45-48, and 50-53 depend, either directly or indirectly, from claims 21, 44, and 49 and therefore includes all the limitations of their respective independent claims. Thus, claims 21, 29, 31, and 44-53 are patentable over *Constien*. See 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, for at least these reasons, Applicants respectfully request withdrawal of this rejection with respect to claims 21, 29, 31, and 44-53.

CONCLUSION

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicits timely notice of the same.

Applicants hereby petition for a three-month extension of time to file this Request under 37 C.F.R. § 1.136(a), extending the deadline from September 15, 2009 to December 15, 2009. Accordingly, Applicants have authorized via the Office's electronic filing system the Commissioner to debit the Deposit Account of Baker Botts L.L.P., Deposit Account No. 02-0383, Order Number 063718.1133, in the amount of \$1110.00 under 37 C.F.R. § 1.17(a)(1) for the three-month extension of time, extending the period to reply up to and including December 15, 2009. Should the Commissioner deem that any fees are due, the Commissioner is authorized to debit Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.1133, for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,



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